

REMARKS

Claims 1, 2, 4, 5, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29 remain pending in the present application. Claims 1, 9, 19 and 29 are amended

Double Patenting

The Examiner provisionally rejected the claims on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of co-pending Application No. 10/959,186. At the appropriate time, the Applicants will submit a terminal disclaimer if necessary to overcome this rejection.

Claims 1, 2, 4, 5 and 29 over Sato in view of Borland and further in view of Rydbeck

Claims 1, 2, 4, 5 and 29 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Sato, JP027212829A ("Sato"), in view of Borland, U.S. 6,556,965 ("Borland") and further in view of International Publication Number WO 99/143,136 to Rydbeck et al. ("Rydbeck"). The Applicants respectfully traverse the rejections.

Claims 1, 2, 4, 5 and 29 recite a remote handset of a cordless telephone that has an integrated MPEG audio player and that a user can initiate an action to mute music playing from the MPEG audio when the cordless telephone receives a telephone call.

Sato discloses a digital cordless telephone that can play music even in a place distant from a sound source by transmitting and receiving a digital music signal from digital audio equipment or an ISDN line. Abstract. As the Examiner admits (Office Action, p. 4), Sato does not disclose an MPEG audio player integrated within either the remote handset or the base unit. The Examiner relies on Borland to make up this deficiency. The Applicants respectfully disagree.

Sato's invention is a digital cordless telephone set that can output high quality music "even in a place distant from a sound source" by receiving the digital music signal from a digital audio equipment or an ISDN line. Nothing in

Sato is concerned with integrating an MPEG audio player in the cordless telephone itself. The Examiner states that it would have been obvious to one of ordinary skill in the art to modify Sato with Borland in order to provide high quality audio signal. This, however, is not a reason to integrate an MPEG audio player into Sato. Borland is not concerned with having a cordless telephone that can be used as an MPEG audio player. Therefore the combination of Sato and Borland is improper.

Moreover, even if Sato and Borland are properly combinable, the combination does not disclose or suggest the muting of playing of music by the user initiating an action when the cordless telephone receives a telephone call, as set forth in Claims 1, 2, 4, 5 and 29. The Examiner relies on Rydbeck to make up this deficiency. The Applicants respectfully disagree.

As noted, Sato and Borland are not properly combinable. Even if they were properly combinable, neither Sato nor Borland is concerning with having a cordless telephone with an integrated MP 3 player that can be used as a telephone or an MP3 audio player. A cellular telephone is not a remote handset of a cordless telephone. Rydbeck fails to disclose or suggest application of any of the features disclosed for a cordless telephone, much less a remote handset of a cordless telephone. As discussed above, "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

Moreover, Rydbeck discloses a cellular telephone that includes an internally integrated digital entertainment module (Abstract). Audio is played back through a headset while a user engages in leisure activities and automatically mutes or stops playback of the audio until a call is terminated (See Rydbeck, page 7, lines 4-8). Therefore, Rydbeck does not teach a user's initiating an action to mute the playing of MP3 music when the cordless telephone receives a phone call, as recited in Claims 1, 2, 4, 5 and 9.

Therefore, even assuming Sato, Borland and Rydbeck are properly combinable, these references, either alone or in combination, fail to teach or disclose muting the playing of MP3 music by the user initiating an action when

the cordless telephone receives a telephone call, as recited by claims 1, 2, 4, 5 and 9.

For these and other reasons, claims 1, 2, 4, 5 and 29 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 9, 10, 19 and 20 over Sato in view of Borland and further in view of Tuoriniemi

Claims 9, 10, 19 and 20 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Sato in view of Borland in view of U.S. Patent No. 5,978,689 to Tuoriniemi et al. ("Tuoriniemi"). The Applicants respectfully traverse the rejections.

Claims 9, 10, 19 and 20 recite pre-loading music into memory of a cordless telephone and a user's initiating an action to mute the playing of the pre-loaded MP3 music when a cordless telephone receives a telephone call.

The Examiner relies on the combination of Sato and Borland to teach a cordless telephone with an integrated MPEG player and playing the pre-loaded MP3 music. As explained above, Sato and Borland are not properly combinable. Even if they were properly combinable, Sato and Borland do not disclose or suggest having a cordless telephone with an integrated MP 3 player that can be used as a telephone or an MP3 audio player

The Examiner acknowledges that the combination of Sato and Borland do not disclose muting the playing of the pre-loaded music when the remote handset is active in a current telephone call. Office Action, p. 6. The Examiner relies on Tuoriniemi to remedy this deficiency. The Applicants respectfully disagree.

Tuoriniemi discloses a personal communication and audio set that is able to play a stored digital audio program (See Fig. 1; col. 9, lines 17-20). Tuoriniemi discloses a cordless telephone within the background of the invention; however, Tuoriniemi's invention is directed to a personal communication and audio set that does not have the shortcomings associated with a cordless telephone. Thus, the Examiner has again failed to refute that Tuoriniemi teaches

away from applying any teachings to a cordless telephone. MPEP §2141.02, page 2100-127 (Rev. 2, May 2004) (citing W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). Tuoriniemi's playing a stored digital audio program from a personal communication and audio set is not playing MP3 music from a remote handset of a cordless telephone, much less a user's muting the playing of pre-loaded MP3 music when the cordless telephone receives a telephone call, as recited by claims 9, 10, 19 and 20.

Thus, even if it were obvious to modify the combination of Sato and Borland with the disclosure of Tuoriniemi, which it is not as discussed above, the theoretically modified combination would still fail to disclose or suggest playing MP3 music from a remote handset of a cordless telephone and a user's muting the playing of a pre-loaded MP3 music when cordless telephone receives a telephone call, as recited by claims 9, 10, 19 and 20.

For these and other reasons, claims 9, 10, 19 and 20 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 14, 15, 24, 25 and 28 over Sato in view of Borland and further in view of Segal

Claims 14, 15, 24, 25 and 28 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Sato in view of Borland and further in view of U.S. Patent No. 6,167,251 to Segal et al. ("Segal"). The Applicants respectfully traverse the rejections.

Claims 14, 15, 24, 25 and 28 recite downloading a digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source accessible by the remote handset via an Internet.

The Examiner acknowledges that the combination of Sato and Borland fails to disclose "downloading digital bit stream music comprised in an MPEG format to said handset directly from a remote bit stream audio source and storing said downloaded digital bit stream music in an MPEG format in said remote handset, wherein said downloaded digital bit stream music comprised in

an MPEG format is stored in Flash memory in said remote handset.” (See Office Action, page 8). The Examiner relies on Segal to remedy this deficiency. The Applicant respectfully disagrees.

Segal appears to disclose a keyless portable cellular phone system having remote voice recognition. Segal does teach downloading digital bit stream music comprised in an MPEG format, but to a cellular telephone. Col. 30, line 15-32. Thus, Segal teaches what is well known in the art, namely downloading digital data to a cellular telephone. Segal, however, fails to disclose or suggest any application to a remote handset of a cordless telephone, much less disclose downloading a digital bit stream music comprised in an MPEG format to a remote handset directly from a remote bit stream audio source accessible by the remote handset via an Internet, as recited by claims 14, 15, 24, 25 and 28.

Moreover, it is quite different to transmit digital data directly to the handset of a cordless telephone than to a cellular telephone. The handset of a cellular telephone necessary must have the capability of receiving digital data in order to function. The handset of a cordless telephone ordinarily is designed to receive RF signals from the base set. In order to transmit digital data directly from a source to the handset, the handset must be modified to have the capability to receive such data. Therefore, it would not be obvious to modify the assumed combination of Sato and Borland to add the capability of Segal.

For these and other reasons, claims 14, 15, 24, 25 and 28 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William H. Bollman", written over a horizontal line.

William H. Bollman
Reg. No. 36,457

MANELLI DENISON & SELTER PLLC

2000 M Street, NW 7TH Floor
Washington, DC 20036-3307
TEL. (202) 261-1020
FAX. (202) 887-0336
WHB/df